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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,690	10/28/2003	Manfred Gilbert	21295.68 (H745US)	3928
29127	7590	04/20/2005	EXAMINER	
HOUSTON ELISEEVA 4 MILITIA DRIVE, SUITE 4 LEXINGTON, MA 02421			PRITCHETT, JOSHUA L	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/694,690

Applicant(s)

GILBERT, MANFRED

Examiner

Joshua L. Pritchett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/03</u> .   | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 5, 8-11 and 20 are objected to because of the following informalities:

Regarding claim 5, claim 5 states, "the XYZ stages," the parent claim 1 mentions only "an XYZ stage". The examiner suggests amending claim 5 to say "the XYZ stage."

Regarding claims 8-11, claim 8 states, "the macroscopes," but claim 8 depends from claim 5 and claim 1 which does not mention macroscopes. The examiner suggest amended claim 8 to state "the subsystems."

Regarding claim 20, claim 20 states, "the PC," but claim 20 depends from claim 13 which does not mention a PC. The examiner suggest amending claim 20 to state, "a PC."

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 5 and 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Garner (US 5,557,456).

Regarding claims 1 and 4, Garner discloses two image acquiring optical subsystems (1 and 7) a bridge which connects the two microscope subsystems mechanically and optically to one another (Fig. 1), an XYZ stage (3) movable in motorized fashion provided for each image-acquiring optical subsystem (Fig. 1) and a control unit (10) for moving the XYZ stage in motorized fashion, synchronously in all three spatial directions (Fig. 1).

Regarding claim 5, Garner discloses the displacement of the XYZ stage in the X direction, Y direction and Z direction, a motor (4-6) provided which receives the signals of the control unit and converts them into corresponding rotation (Fig. 1).

Regarding claim 8, Garner discloses the control unit is a control and adjustment apparatus that is associated with the subsystems and a first remote control device (9) is respectively connected to the first subsystem (7) and a second remote control device (11) is connected to the second subsystem (1; Fig. 1).

Regarding claim 9, Garner discloses the control and adjustment apparatus possesses an X actuation element (6), a Y actuation element (5) and a Z actuation element (4) for displacing the XYZ stage (Fig. 1). The XYZ stage of Garner is associated with both subsystems and therefore the actuators work for both subsystems.

Regarding claim 10, Garner discloses the control and adjustment apparatus encompasses an on/off switch for synchronous displacement of the two XYZ stages which acts in such a way that when the on/off switch for synchronous displacement is switched on, both the XYZ stages are movable synchronously regardless of the actuation of the X, Y or Z actuation elements (col. 3

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lines 50-58). Garner states that when one or more of the manual control knobs are moved the manual controls take over for the computer driven controls.

Regarding claim 11, Garner discloses the first remote control device and the second remote control device encompass a plurality of actuation elements; and the actuation elements of the first remote control device and the second remote control device are also synchronizable in pairs (Fig. 1; 14, 16, 18; col. 2 lines 6-11).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garner in view of Reichel (US 4,403,839).

Garner teaches the invention as claimed but lacks reference to the use of macroscopes. Reichel teaches that macroscopes are well known replacements for microscopes (abstract). It would have been obvious to a person of ordinary skill in the art at the time the invention was

made to have the microscope of Garner be a macroscope as taught by Reichel for the purpose of viewing larger sized objects.

Claims 3 and 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garner.

Regarding claims 12 and 19, Garner teaches the invention as claimed including the use of a comparison optical system associated with a PC (9) that supplies signal to the comparison optical system and receives image data or settings data from the comparison optical system. Garner lacks reference to a RS232 or USB connection. Both RS232 and USB connections are extremely well known means of connecting a computer to another electronic device. Official Notice is taken. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the PC of Garner connected to the microscope by a USB or RS232 cable as is known in the art for the purpose of efficiently and reliably relaying signals between the two devices.

Regarding claims 3 and 13, Garner teaches two optical subsystems that operate to receive microscope images (1 and 7) a bridge which connects the two microscope subsystems mechanically and optically to one another (Fig. 1), an XYZ stage (3) movable in motorized fashion provided for each image-acquiring optical subsystem (Fig. 1) and a control unit (10) for moving the XYZ stage in motorized fashion, synchronously in all three spatial directions (Fig. 1). The Garner reference has two separate image sensors, the eyepieces of the microscope (1) and the image sensor. These two separate sensor act as two microscopes associated with the same viewed specimen. It would have been obvious to one of ordinary skill in the art at the time

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the invention was made to have the Garner invention interpreted as having two microscopes because both image sensors (1 and 7) are used to capture microscopic images.

Regarding claim 18, Garner teaches the displacement of the XYZ stage in the X direction, Y direction and Z direction, a motor (4-6) provided which receives the signals of the control unit and converts them into corresponding rotation (Fig. 1).

Regarding claim 14, Garner teaches the control unit is a control and adjustment apparatus that is associated with the subsystems and a first remote control device (9) is respectively connected to the first subsystem (7) and a second remote control device (11) is connected to the second subsystem (1; Fig. 1).

Regarding claim 15, Garner teaches the control and adjustment apparatus possesses an X actuation element (6), a Y actuation element (5) and a Z actuation element (4) for displacing the XYZ stage (Fig. 1). The XYZ stage of Garner is associated with both subsystems and therefore the actuators work for both subsystems.

Regarding claim 16, Garner teaches the control and adjustment apparatus encompasses an on/off switch for synchronous displacement of the two XYZ stages which acts in such a way that when the on/off switch for synchronous displacement is switched on, both the XYZ stages are movable synchronously regardless of the actuation of the X, Y or Z actuation elements (col. 3 lines 50-58). Garner states that when one or more of the manual control knobs are moved the manual controls take over for the computer driven controls.

Regarding claim 17, Garner teaches the first remote control device and the second remote control device encompass a plurality of actuation elements; and the actuation elements of the

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first remote control device and the second remote control device are also synchronizable in pairs (Fig. 1; 14, 16, 18; col. 2 lines 6-11).

Regarding claim 20, Garner teaches the XYZ stage synchronization switched on and off by way of a PC (col. 3 lines 50-58).

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Takabayashi (US 5,043,570) teaches a microscope with two subsystems with an XY stages mounted on springs for potential movement in the Z direction.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

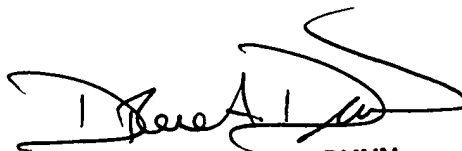
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLP *JP*

A handwritten signature in black ink, appearing to read "Drew A. Dunn", with a large, sweeping flourish extending from the end of the signature.

**DREW A. DUNN**  
**SUPERVISORY PATENT EXAMINER**